

### REMARKS

Applicants submit this Request for Continued Examination (RCE) and Amendment in response to the Board of Patent Appeals and Interferences Decision dated June 9, 2008 where the rejections of Claims 9-16 for obviousness under 35 U.S.C. § 103(a) were affirmed. Claims 9-16 are pending and stand rejected. Claim 9 has been amended to further define various features of Applicant's invention. Applicant respectfully requests reconsideration and favorable action in this case.

#### **Rejections under 35 U.S.C. § 103**

Claims 9-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over PCT Publication 98/30053 filed by Holmstrom et al. ("*Holmstrom*") in view of U.S. Patent No. 6,009,338 issued to Yuji Iwata et al. ("*Iwata*"). Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

In order to establish a prima facie case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Even if each limitation is disclosed in a combination of references, however, a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Rather, the Examiner must identify an apparent reason to combine the known elements in the fashion claimed. *Id.* "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Finally, the reason must be free of the distortion caused by hindsight bias and may not rely on ex post reasoning. *KSR*, 127 S.Ct. at 1742. In addition, evidence that such a combination was uniquely challenging or difficult tends to show

that a claim was not obvious. *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc. and Mattel, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007), citing *KSR*, 127 S.Ct. at 1741.

Applicants respectfully submit that the cited references fail to teach and every limitation of Claim 9. For example, Applicants submit that the cited references, either alone or in combination, do not teach, disclose or suggest "at least one database stored in the nonvolatile memory and, each of the at least one database being respectively assigned to *precisely* one of the at least one electronic telephone directory," as recited in amended Claim 9. For at least this reason, the cited references fail to disclose, teach, or suggest each limitation of Claim 9, and thus cannot render obvious Claim 9. Given that Claims 10-16 depend from Claim 9, Applicant submits that Claims 10-16 are also allowable. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a), and full allowance of Claims 9-16, as amended.

**Association of Customer Number and Change of Correspondence Address**

Applicants respectfully request that all papers pertaining to the above-captioned patent application be associated with Customer No. **31625**, and direct all correspondence pertaining to this patent application to practitioners at Customer Number **31625**. All telephone calls should be directed to Brian K. Prewitt at 512.322.2684. A Revocation and Power of Attorney will be submitted shortly.

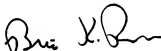
**CONCLUSION**

Applicants have made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

Applicants believe there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2684.

Respectfully submitted,  
BAKER BOTTS L.L.P.  
Attorney for Applicants



Brian K. Prewitt  
Registration No. 60,135

Date: August 8, 2008

SEND CORRESPONDENCE TO:  
BAKER BOTTS L.L.P.  
CUSTOMER ACCOUNT NO. **31625**  
512.322.2684  
512.322.8383 (fax)